

## **REMARKS**

With careful attention to the Examiner's comments in the Office Action dated June 15, 2007, the Application has been amended to place it in condition for allowance. The remarks presented herein are believed to be fully responsive to the Office Action, the period for response being extended to October 15, 2007 via the Petition and fee for one month extension of time.

Claims 1-4, 6 and 8-20 are pending in the present application.

### **CLAIM REJECTIONS:**

#### **Claim Rejection under 35 U.S.C. § 103**

**LEGAL PRINCIPLE** - To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all claim limitations. The teaching or suggestion to make the claim combination or combine the references and the reasonable expectation of success must both be found in the prior art and not based on the Applicant's disclosure. In re Vaeck, 947 F.2d 488 (Fed. Cir. 1991).

With regard to the first criteria for a suggestion or motivation to modify or combine references, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of

the problem to be solved as a whole would have suggested to those of ordinary skill in the art. In re Kotzab, 217 F.3d 1368 (Fed. Cir. 2000). Courts and patent examiners should determine whether needs or problems known in the field and addressed by the prior art references can provide a reason for combining the elements in the manner claimed. KSR Intern. Co. v. Teleflex Inc., No. 04-1350, 2007 WL 1237837, at 4 (Apr. 30, 2007). "In formulating a rejection under 35 USC § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed." Memo on KSR Decision to Examiners issued by the United States Patent and Trademark Office, May 4, 2007. The prior art is not sufficient to establish obviousness without some objective reason to combine the teachings of the references. In re Kotzab, 217 F.3d 1368 (Fed. Cir. 2000), also see In re Sang Su Lee, 277 F.3d 1338 (Fed. Cir. 2002). Also, the proposed modification would render the prior art being modified unsatisfactory for its intended purpose and there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900 (Fed. Cir. 1984).

The Office Action states that claims 1-3, 6 and 8-20 stand rejected under 35 U.S.C. 103(a), as allegedly being unpatentable Axelrod et al. in view of Wang.

*Claims 1 and 12*

With regard to claims 1 and 12, the Office Action states:

Axelrod et al discloses a pet chew including animal meal, starch, a copolymer, vitamin C and E and other nutraceuticals in the amounts claimed by applicant. The components are formed into the pet chew by blending and injection molding. With Wang, it would have been obvious to substitute meat, e.g., chicken meat, for the animal meat

used in the pet chew of Axelrod et al since meat, e.g., chicken meat, and animal meat, e.g., chicken powder, are used alternatively as components in a pet chew, as evidenced by Wang (col. 3, lines 31-40).

The Office Action further states:

Finding the optimum animal meal particle size (claim 1 and 12) and the optimum molding parameter (claims 14, 15, and 19) would require nothing more than routine experimentation by one reasonable skilled in this art. The particle size of applicant's animal component is not critical, and in the absence of unexpected results is entitled to no patentable weight but rather merely depends upon personal preference and consumer appeal.

This rejection is respectfully traversed. It is clear that neither Axelrod et. al. nor Wang, discloses or teaches the particle size recited in the claims of the present invention. The claims of the present invention recite an animal chew toy with "a particle size of between about 300 and about 1,200 microns." The particle size of the meat product is an important condition for manufacturing the pet products, such as the animal chew toy, particularly needed for blending and molding processes. Furthermore, the particle size of the meat product is an important condition for the final product because it should meet the customer's preference (actually the pets' preference). In support of its position, Applicant hereby submits to this Response to Final Office Action a Declaration of inventor Robert Milligan, pursuant to 37 C.F.R. §1.132. *Exhibit A.*

The Examiner asserts that the finding the optimum animal meal particle size (claim 1 and 12) and the optimum molding parameter (claims 14, 15, and 19) would require nothing more

than routine experimentation by one skilled in this art. However, as discussed above, this is not about optimum range of the conditions. Wang does not disclose or teach the recited limitation “a particle size of between about 300 and about 1,200 microns.” For example, Wang discloses “chicken powder and turkey powder.” The “powder” is known in the art to be a term utilized to refer to a particle size that is substantially smaller than 300 microns. As such, the particle size of between about 300 and about 1,200 microns is not the optimal size of the ingredients disclosed by Wang. In terms of suggestion or motivation to make the proposed modification, to the contrary, Wang teaches away from the particle size of between about 300 and about 1,200 microns. There is no motivation to combine if a reference teaches away from its combination with another source. Tec Air., Inc. v. Denso Mfg. Michigan Inc., 192 F.3d 1353, 1360 (Fed. Cir. 1999).

Further, the Examiner asserts that the particle size of Applicant’s animal component is not critical, and in the absence of unexpected results is entitled to no patentable weight but rather merely depends upon personal preference and consumer appeal. The issue of whether or not the limitation of the particle size is critical is irrelevant to determine non-obviousness because the prior art reference (or references when combined) must teach or suggest all claim limitations. The consumer preference is also irrelevant. Any distinctive technical features to obtain more consumer preferences can be legitimate objects of the patentable invention. Without some suggestion or direction in these references for their combination or for them to be combined to produce the invention, given the lack of disclosure or direction of the claimed elements, these references simply will not support an obviousness rejection.

At best, Wang and Axelrod et. al. are nothing but an invitation to experiment with no direction on how to make a chew toy for a pet having animal meat of chunk particle size. There

is simply no direction in neither of these references to the present invention. The only direction is through the application of forbidden hindsight. It is respectfully requested that the Patent Office reconsider and withdraw the rejections of the claims for the reasons stated above.

Additionally, claims 2, 3, 6, and 8-11 depend from claim 1, and thus include all limitations of claim 1. Consequently, claims 2, 3, 6, and 8-11 are also respectfully submitted to be allowable. However, Applicant reserves the right to dispute the bases used to reject claims 2, 3, 6, and 8-11 apart from those used to reject independent claim 1.

Claims 13-20 depend from claim 12, and thus include all limitations of claim 1. Consequently, claims 13-20 are also respectfully submitted to be allowable. However, Applicant reserves the right to dispute the bases used to reject claims 13-20 apart from those used to reject independent claim 12.

Claim 4 stands rejected as being obvious over Axelrod et. al. in view of Wang as set forth in the first portion of the rejection and further view of Gluck et. al. Gluck et. al. adds nothing more to the teaching of the two principle references except the teaching of avoiding the use of animal products in such chew toys. See for example column 1, lines 26-30. Regardless, Gluck, et. al. do not teach how to practice the present invention and does not use any copolymer in its formula. The fact that it discloses the use of cartilage does not add to the teaching of the other two references. Regardless, Claim 4 depends from an allowable claim and thus is patentable for this reason alone.

Therefore, Applicant asserts that claims 1 and 12 as amended and claims 2, 3, 4, 6, 8-11, and 13-20 depending therefrom are now in condition for allowance.

**CLAIM OBJECTION:**

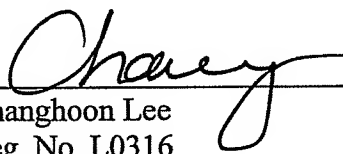
Claims 1 and 12 stand rejected as being indefinite. Applicant respectfully submits amendment of claims 1 and 12, in accordance with the Examiner's suggestion.

Applicant's request for extension of time under 37 CFR 1.136(a) as well as Applicant's petition fee are enclosed herewith and filed simultaneously with this response.

Applicant respectfully submits the claims are in condition for formal allowance which is courteously solicited. If any issue regarding the allowability of any of the pending claims in the present application could be readily resolved, or if other action could be taken to further advance this application such as an Examiner's amendment, or if the Examiner should have any questions regarding the present amendment, it is respectfully requested that the Examiner please telephone Applicant's undersigned attorney in this regard. Should any fees be necessitated by this response, the Commissioner is hereby authorized to deduct such fees from Deposit Account No. 11-0160.

Respectfully submitted,

Date: October 15, 2007

  
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